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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/885,186

06/20/2001

Kimmo Kinnunen

413-010355-US(PAR)

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11/12/2003

PERMAN & GREEN
425 POST ROAD
FAIRFIELD, CT 06824

EXAMINER

FOX, BRYAN J

ART UNIT

PAPER NUMBER

2686

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,186

Applicant(s)

KINNUNEN ET AL.

Examiner

Bryan J Fox

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 6 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 recites the limitation "the authorities". There is insufficient antecedent basis for this limitation in the claim. It is not clear who the authorities are.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 15, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Prior, et al (EP000913977A2).

Regarding claim 1, Prior, et al discloses a radiotelephone handset with a keypad 7, which reads on the claimed "keypad", a display 3, which reads on the claimed "display", a microphone 6, which reads on the claimed "microphone" and an earpiece 5, which reads on the claimed "speaker" all located on the front of the shell and together read on the claimed "first functional elements" (see figure 1). An on/off button 4 is located on the upper end of the shell and more keys are located on the side of the phone as can be seen in figure 2, which read on the claimed "second functional elements placed at the upper end of the shell or on the sides of the shell, which second functional elements comprise various function keys". In figure 3, it can be seen that

keys 25 and 26 are located on the rear of the phone, which read on the claimed "third functional elements placed on the rear surface of the shell of the radio telephone".

Regarding claim 2, Prior, et al discloses in column 5, lines 34-35 and in figure six an alternative user interface on the rear of the handset, which reads on the claimed "second alternative user interface of a phone".

Regarding claim 3, Prior, et al discloses in column 1, lines 7-10 that important user interface considerations include the ease of which the phone can be transported and on lines 30-31 that the input means on the rear face of the handset, which reads on the claimed "third functional elements", promotes single handed operation. It is clear that the phone is intended to be used while being carried in one hand, which reads on the claimed "carrying means".

Regarding claim 4, Prior, et al discloses in column 7, lines 30-31 that a group may be selected by soft key 81, which reads on the claimed "group selector switch" and it can be seen in figure 8a that soft key 81 is located on the rear of the phone, which reads on the claimed "third functional elements".

Regarding claim 5, Prior, et al discloses in figure 11 and in column 9, lines 37-38, an interface with actuable rolling means 111 which control the menu options on the display, which reads on the claimed "rotary switch for selecting a group by turning the selector switch".

Regarding claim 6, Prior, et al discloses in column 8, line 48 that the soft key 81 can be depressed and as described above can be used to select a group, which reads on the claimed "pushbutton switch for selecting a group by pushing the selector switch".

Regarding claim 15, Prior, et al discloses that the key 26 (see figure 3) may have a dedicated function, such as a voice recognition function, which enables the user to store and retrieve data from the handset's memory (see column 4, lines 54-57), which reads on the claimed "speech recognition button to use functions in the phone that can be controlled by the user's voice commands".

Regarding claim 18, police may use the radiotelephone handset disclosed by Prior, et al.

Regarding claim 19, civilians may use the radiotelephone handset disclosed by Prior, et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prior, et al in view of Davidson, et al (US005841855A). Prior, et al fails to disclose a key to select a previous group.

Davidson, et al discloses a terminal with a back key 221 (see figure 3) and in column 4, lines 7-8 describes that its function is to allow a user to back up menu screen by menu screen, which reads on the claimed "pushing of the said group selector switch is arranged so as to select the previous selected group".

It would be obvious to one skilled in the art at the time of the invention to modify Prior, et al to include the back button in Davidson, et al in order to create a more user-friendly and intuitive interface.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior, et al in view of Bannister, et al (2012199).

Regarding claims 8 and 9, Prior, et al fails to disclose a voice response function. Bannister, et al discloses an audible voice signal which may be included in the presenting means on page 10, lines 20-21, which reads on the claimed "voice response function arranged in conjunction with the group selector switch to convey information to the user by means of a recorded voice message". Bannister, et al also discloses on page 10, line 1 that selection of a soft key in one menu can cause another menu to be displayed. Each menu is a group and the soft key that selects the menu is a group selector switch. Bannister, et al further discloses on lines 24-26 that the message is relayed as each soft key is highlighted, which reads on the claimed "group name or index is given in the said recorded voice message".

It would be obvious to one skilled in the art at the time of the invention to modify Prior, et al with Bannister, et al to include the above message function in order to in prevent the need for a user to divert his attention to a display when in a situation such as driving a car.

Regarding claim 10, in Bannister, et al the function of the softkey is read off as it is highlighted, after which it may be selected and the new menu is displayed, as

described above. Therefore, there must be a delay between the message and the transition to the group as claimed.

Regarding claim 11, Bannister, et al discloses that as each soft key is highlighted it can be read to the user by a voice synthesizer, so as each group, represented by a soft key, is selected, or highlighted, the voice synthesizer reads the name to confirm selection, as claimed.

Claims 12, 13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior, et al in view of Gordon (US005884156A).

Regarding claim 12, Prior, et al does not disclose a rear speaker.

Gordon discloses a portable communication device with a second speaker 18 (see figure 1) mounted on the rear of the phone, which reads on the claimed "rear speaker".

It would be obvious to one skilled in the art at the time of the invention to modify Prior, et al with Gordon to include the above speaker in order to allow a user to route certain communications to a louder speaker so that they may be heard without needing the device beside ones ear.

Regarding claim 13, Prior, et al does not disclose that the phone could function as a direct channel radio.

Gordon discloses in column 1, lines 7-8 that his device could provide communications in a telephony mode, which reads on the claimed "systems radio", and in a radio dispatch mode, which reads on the claimed "direct channel radio".

It would be obvious to one skilled in the art at the time of the invention to modify Prior, et al to include the above radio dispatch mode disclosed by Gordon in order to eliminate the need for two separate devices and reuse some of the common circuitry.

Regarding claim 17, Prior, et al does not disclose a method to switch automatically between two speakers.

Gordon discloses a proximity sensor to determine when a user is near the first side of the housing and the operation of the first and second speaker is controlled accordingly (see column 1, lines 55-60), which reads on the claimed "automatic function for setting the voice messages to be automatically reproduced by the rear speaker when the phone is in carrying means and for setting the voice message to be reproduced by the speaker when the phone is not in the carrying means".

It would be obvious to one skilled in the art at the time of the invention to modify the above combination of Prior, et al and Gordon to include the automatic function in order to eliminate the need for the user to manually switch between the two speakers.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prior, et al in view of Johansson (EP000865184A1).

Regarding claim 14, Prior, et al does not disclose a microphone in the rear.

Johansson discloses an electronic unit with a microphone 18 in the rear as can be seen in figure 3A, which reads on the claimed "rear microphone".

It would be obvious to one skilled in the art at the time of the invention to modify Prior, et al with Johansson to include the above rear microphone in order to save space on the phone.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prior, et al in view of Johansson as applied to claim 12 above, and further in view of Fishman (US005655017A). The combination of Prior, et al and Johansson does not disclose a selection switch to choose the speaker.

Fishman discloses a phone with a normal speaker 20 and an additional speaker 26 in the rear (see figure 1) and that a separate switch can be provided to turn the speakerphone on and off (see column 3, lines 49-51), which reads on the claimed "selection switch for setting the incoming voice messages to be reproduced by the speaker or the rear speaker".

It would be obvious to one skilled in the art at the time of the invention to modify the combination of Prior, et al and Johansson with Fishman to include a switch to choose which speaker is used in order to allow a user to customize the unit to function according to his preferences.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J Fox whose telephone number is (703) 305-0997. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

BJF

Nguyen V8
11/3/03

NGUYEN T. VO
PRIMARY EXAMINER